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**APR 27 2006**

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In re Application of: Wilson, et al. )  
Application No. 09/641,431 ) DECISION ON PETITION FOR  
Attorney Docket No. INTL-0434-US ) SUPERVISORY REVIEW  
(P9442) ) UNDER 37 CFR §1.181  
Filed: August 18, 2000 )  
For: COMMUNICATING OBJECTS )  
BETWEEN USERS OR APPLICATIONS )

This is in response to the petition filed on November 23, 2005, under 37 CFR §1.181 or in the alternative, under 37 CFR §1.182, to review of the denial of entry of the amendment filed May 6, 2005. The petition is being treated under 37 CFR §1.181 to enter the amendment filed May 6, 2005.

A petition under this section must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. The petition filed November 23, 2005 includes elements (1) and (2) above.

The petition is **DENIED in part** and **GRANTED in part**, to the extent indicated below.

**RECENT PROSECUTION HISTORY**

On March 30, 2005, a Board of Patent Appeals and Interferences decision was mailed to Appellant, affirming the Examiner by sustaining the rejection of claims 1-6, 10-16 and 20-30. A new ground of rejection by the Board was also added for claims 29-30.

On May 6, 2005, a reply to the new grounds of rejection by the Board was filed, including canceling claims 1-28, amending claims 29-30, and adding new claims 31-53.

On June 27, 2005, Applicant filed an information disclosure statement.

On September 22, 2005, an advisory action was mailed to Applicant, indicating the amendment filed May 6, 2005 would not be entered.

On November 23, 2005, the instant petition under 37 CFR §1.181 was filed.

## RELIEF REQUESTED

The instant petition under 37 CFR 1.181 requests the following relief: to (1) enter the amendment for consideration submitted on May 6, 2005 as appropriate; or if the amendment is determined to be inappropriate, (2) opportunity to submit an appropriate amendment.

## BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to critical phrases.

MPEP § 1213.02 and 37 CFR § 41.50 state in-part:

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) **Reopen prosecution . Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected**, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) Request rehearing . Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

MPEP § 1214.01 states in-part:

When the Board makes a new rejection under 37 CFR \*41.50(b)<, the appellant, as to each claim so rejected, has the option of:

(A) > **reopening prosecution before the examiner by< submitting an appropriate amendment and /or \*\*>new evidence (37 CFR 41.50(b)(1))<**; or

(B) requesting rehearing \*\*>before the Board (37 CFR 41.50(b)(2))<.

The amendment and/or \*\*>new evidence< under 37 CFR \*> 41.50(b)(1)<, or the request for rehearing under 37 CFR \*> 41.50(b)(2)<, must be filed within 2 months from the date of the Board's decision. In accordance with 37 CFR 1.196(f), this 2-month time period may not be extended by the filing of a petition and fee under 37 CFR 1.136(a), but only under the provisions of 37 CFR 1.136(b), or under 37 CFR 1.550(c) if the appeal involves an ex parte reexamination proceeding.

### I. SUBMISSION OF AMENDMENT OR \*\*>NEW EVIDENCE<

37 CFR \*> 41.50(b)(1)< provides that the application will be remanded to the examiner for reconsideration if the appellant submits "**an appropriate amendment**" of the claims rejected by the Board, "**or \*\*>new evidence< relating to the claims so rejected**, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. Ex parte Burrowes, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904).

The new ground of rejection raised by the Board does not reopen \* prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR \*> 41.50(b)< was made includes an affirmation of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution.

37 CFR \*> 41.52(3) provides:

(3) New arguments **responding to a new ground of rejection made pursuant to § 41.50(b)** are permitted.

37 CFR § 1.198 provides:

§ 1.198 Reopening after a final decision of the Board of Patent Appeals and Interferences. When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, **prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.**

[49 FR 48416, Dec. 12, 1984, effective date Feb. 11, 1985; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004].

## ANALYSIS

In light of the guidance provided by MPEP and in consideration of 37 CFR § 41.50 (noted above), it is clear that the amendment and evidence submitted, in order to be considered appropriate, must be directed to the claims “so rejected by the Board”. Since the amendment submitted on May 6, 2005 was directed to both the claims newly rejected by the Board (i.e. claims 29-30) as well as to propose the addition of new claims 31-53, including the addition of new limitations and considerations, the submission clearly includes amendments that are beyond that considered to be “appropriate” in accordance with rule 41.50. Further, and in accordance with rule 1.198, prosecution will not be reopened or reconsidered without sufficient cause being shown and then only for matters not already adjudicated by the Board.

Finally, and in view of Applicant’s comments filed with the amendment of May 6, 2005, i.e. “As amended, claim 29 overcomes the objection set forth in the Board’s decision ... Moreover, *additional limitations* have been added to further establish the patentability thereof”, Applicant is cautioned to limit amendments, evidence and arguments to the claims so (newly) rejected by the Board, as is required. As set forth in MPEP 1214.01(I), **the new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied [*emphasis added*]**. If the Board’s decision in which the rejection under 37 CFR \* > 41.50(b) < was made includes an affirmance of the examiner’s rejection, the basis of the affirmed rejection is not open to further prosecution.

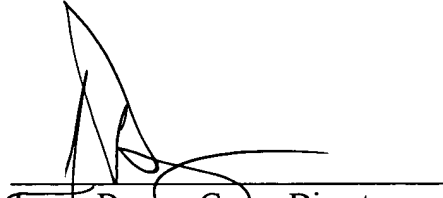
## DECISION

Accordingly, the petition to enter the amendment filed May 6, 2005 is **DENIED**.

Since the submission (amendment) appears to be bona fide attempt to comply, the petition to allow opportunity to submit an appropriate amendment is **GRANTED**. Applicant is given one opportunity within **one (1) month** from the mailing date of this decision in which to provide an amendment in compliance with 37 CFR 41.50(b)(1). This period is not extendable under 37 CFR 1.136(a). Failure to respond within the time frame identified above will result in abandonment of the application. The submission of a further inappropriate or non-compliant amendment will also result in abandonment of this application.

*Application SN 09/641,431*  
*Decision on Petition*

Any inquiries related to this decision may be directed to Special Programs Examiner Brian Johnson on (571) 272-3595.



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